



1155 Avenue of the Americas
22nd Floor
New York, NY 10036-2711

T +1.212.262.6900
F +1.212.977.1649
PerkinsCoie.com

November 18, 2021

Matthew J. Moffa
MMoffa@perkinscoie.com
D. +1.212.261.6857
F. +1.212.399.8057

VIA ECF

Hon. Ronnie Abrams, USDJ
United States District Court
Southern District of New York
40 Foley Square Room 2203
New York, NY 10007

Re: FCX Solar, LLC v. FTC Solar, Inc., Case No. 1:21-CV-03556-RA

Dear Judge Abrams:

The parties in the above-captioned matter (the “License Action”) submit this joint letter motion requesting that this case be consolidated for all purposes, including trial, with *FTC Solar, LLC v. FTC Solar, Inc.*, 1:21-CV-08766-RA (the “Patent Action”) pursuant to Rule 42(a) of the Federal Rules of Civil Procedure.

The Complaint in the License Action was filed on April 21, 2021. It asserts contract and tort claims arising out of FTC’s alleged breach of a patent license agreement between the parties. FTC provided notice of termination of the license agreement by letter dated April 30, 2021. In the Patent Action, FCX alleges that FTC continued to offer, sell, and encourage use of products infringing one of FCX’s patents after the termination of the license. FTC disputes that it breached the license agreement or that it sells or sold products that infringe FCX’s patents.

FCX filed the Patent Action in the United States District Court for the Western District of Texas on May 29, 2021. FTC’s Motion to Transfer the action was granted on October 25, 2021, and the case was transferred to this district and assigned to Judge Crotty. (No. 21-cv-548-ADA, ECF No. 30.) FCX filed Related Case Statements in both the License Action and the Patent Action on October 29, 2021. (No. 21-cv-3556-RA, ECF No. 41; No. 21-cv-8766-RA, ECF No. 32.) Your Honor accepted transfer of the Patent Action on November 9, 2021.

The parties jointly request (and grant their express consent) that the License Action and the Patent Action be consolidated pursuant to Rule 42(a). *See, e.g., Szymczak v. Nissan N. Am., Inc.*, 2012 WL 1877306, at *1 (S.D.N.Y. May 15, 2012) (consolidating actions “[o]n the consent of all parties”). “[A]s long as there will be a fair and impartial trial,” a district court should exercise its discretion to “consolidate actions for trial where there are common questions of law or fact to avoid unnecessary costs or delay.” *Garnett-Bishop v. N.Y. Cmty. Bancorp, Inc.*, 299 F.R.D. 1, 5

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(E.D.N.Y. 2014). The License Action and the Patent Action raise common questions of law and fact regarding the relationship between FCX's intellectual property and certain aspects of FTC's solar tracker products. Consolidating the actions will reduce the burden on the parties and the Court from overlapping discovery, expedite trial, and enhance judicial economy. *Devlin v. Transp. Commc'ns Int'l Union*, 175 F.3d 121, 130 (2d Cir. 1999).

The parties respectfully request that this letter motion be granted. Should the Court grant this motion, the parties will provide a proposed common scheduling order for the consolidated cases within one week of the Court's order.

Respectfully submitted,

/s/ Matthew J. Moffa

Matthew J. Moffa

cc: All counsel of record (via ECF)

Application granted. The Clerk of Court is respectfully requested to consolidate 21-cv-3556 and 21-cv-8766 under the master file of 21-cv-3556.

SO ORDERED.



Hon. Ronnie Abrams
11/19/2021